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Status of Claims:

Claims 1-15 were rejected. Claims 1-3 have been amended. New claims 16-20 have been added. All of the amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

As a preliminary matter, Applicant notes that the present Office Action addresses limitations that are not recited in the present application, and Applicant submits that such treatment of the present claims is improper. In particular, in purporting to address claims 1 and 2 of the present application on page 3 of the present Office Action, the Office states as follows:

Kovacs et al disclose a system and method for detecting tissues comprising a capsule comprising a detector, a substance for associating with a target tissue where the substance is capable of being detected by the detector and a machine for verifying at least one of the detector and substance are suitable for use [sic] (col. 3, line 10 – col. 4, line 59; col. 6, lines 8-56).

Neither of present claims 1 or 2 recites a capsule or a machine for verifying that a detector and substance are suitable for use, nor have they ever recited such features during the pendency of the present application. Incidentally, Applicant notes that the passage quoted above appears to deal with claim 11 that was pending in U.S. Application Serial No. 10/713,637 as of the date that the present Office Action was issued. In fact, the above-quoted passage appears to have been literally copied and pasted from the Office Action that was mailed on 01/26/2006 for U.S. Application Serial No. 10/713,637. This appears to have been done despite Applicant pointing out in Applicant's prior response (filed 12/20/05) that, in the previous Office Action issued against the present application, the Office was addressing claims not being prosecuted in the present application. Again, Applicant respectfully requests that, in the next Office Action, the Office address the claims actually being prosecuted in the present application instead of addressing claims being prosecuted in other applications.

In addition, because both Office Actions issued against the present application address claims of a separate application reciting substantively different subject matter, and because only the second Office Action remotely addresses, in the "Response to Arguments" section, the limitations actually recited in the claims of the present application, Applicant requests that the present Office Action be made non-final. In other words, Applicants respectfully submit that the

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finality of the present rejection is premature. If this request for reconsideration of the finality of the rejection is denied, Applicant intends to file an appropriate Petition to the Technology Center Director within two months of such denial. If Applicant's request that the present Office Action be made non-final is granted, Applicant further respectfully requests that the RCE fee of \$790, which is presently being paid by Applicant, be refunded to deposit account 10-0750/END5005USNP/GSG.

§ 102 Rejections:

Claims 1, 2, and 4-15 were rejected under 35 U.S.C. §102(b) as being anticipated by Kovacs et al. (U.S. 5,833,603). Applicant respectfully traverses these rejections.

Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim, and the elements must be arranged as required by the claim. Under this standard, Applicant submits that Saadat fails to anticipate amended independent claim 1.

Amended independent claim 1 recites a signal emitting substance having and affinity for a particular target cell type. Kovacs et al. fails to teach or suggest such limitations, among others, particularly in the arrangement required by amended independent claim 1. To the extent that Kovacs et al. remotely suggests a signal emitting substance, there is no teaching or suggestion that such a substance have an affinity for a particular target cell type as recited in amended independent claim 1. Accordingly, Applicant respectfully submits that Kovacs et al. fails to anticipate amended independent claim 1 in accordance with MPEP 2131, and respectfully requests that the rejections be withdrawn.

Independent claim 2 also recites a signal emitting substance having and affinity for a particular target cell type. Accordingly, for at least the reasons set forth above with respect to claim 1, Applicant respectfully submits that Kovacs et al. fails to anticipate independent claim 2 in accordance with MPEP 2131, and therefore respectfully requests that the rejections be withdrawn.

Applicant further notes that while the Office Action dated 03/09/06 purported to reject claim 2, the Office Action failed to acknowledge the recitation of the substance affinity that was included in claim 2 prior to the present Office Action being mailed. Applicant submits that the failure of the Office to address each and every limitation recited in the claims is improper. Indeed, MPEP 707.07(d) admonishes against the use of "omnibus rejections,"

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which impermissibly group claims together and fail to address each and every limitation recited in those claims. Such rejections are improper, and the Office is respectfully requested to treat each and every limitation of each and every claim on its own merits in the next Office Action.

§103 Rejections

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kovacs et al. in view of Iddan et al. (U.S. Pat. No. 5,604,531). Applicant respectfully traverses this rejection.

Under MPEP 2143, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all of the limitations of a claim. A *prima facie* case of obviousness also requires that there be some teaching suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In view of the foregoing requirements for a *prima facie* case of obviousness, Applicant submits that the combined art of record fails to render the amended claims obvious. In particular, Applicant notes that the combination of references fails to teach or suggest all of the limitations of each amended independent claim in accordance with MPEP 2143.03. In addition, Applicant submits that even if the combined art of record taught or suggested all of the limitations of each present independent claim, there is no teaching, suggestion, or motivation to modify or combine the references to obtain the invention presently claimed, such that a *prima facie* case of obviousness has not been, and cannot be, established in accordance with MPEP 2143.01.

With respect to amended independent claim 3, Applicant submits that the combined art of record fails to teach or suggest all of the limitations recited in amended independent claim 3. In particular, the combined art of record fails to teach or suggest, among other things, administering a material capable of targeting and binding to a target cell type as recited in claim 3. The combined art of record also fails to teach or suggest, among other things, an act of administering a clearing agent for removing a portion of the material that is not bound to the target cell type as recited in claim 3. The combined art of record therefore fails to render amended independent claim 3 obvious in accordance with MPEP 2143.03. Applicant therefore respectfully requests that the rejections be withdrawn.

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Furthermore, even if the combined art of record taught or suggested all of the elements of any of the independent claims, the art is devoid of any suggestion or motivation to modify or combine the teachings of the references in order to obtain the claimed invention. Indeed, MPEP 2143.01 admonishes that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (emphasis in original). *Actual evidence* of a suggestion, teaching, or motivation to combine prior art references must be shown. *In re Dembiczack*, 50 USPQ2d 1614 (Fed. Cir. 1999). Because the evidence of motivation required by MPEP 2143.01 is lacking, Applicant respectfully requests that the rejection be withdrawn.

Beyond the foregoing shortcomings with respect to the rejections of the independent claims, Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty and non-obviousness.

To the extent that the present amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. While Applicant has noted several distinctions over the art of record, Applicant notes that several other distinctions exist, and Applicant preserves all rights and arguments with respect to such distinctions.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully submitted,

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